

## **Remarks**

### **A. Status of the Claims**

Claims 11, 14, 27-29, 32, 36, 37, 45, 48, 49, 57-59, 64, 65, 74, 82-84, 86, 91, 93, 97 and 110 are amended. Claims 1-10, 12-13, 15-26, 30-31, 33-35, 47, 85, 87-90 and 92 are cancelled without prejudice to the subject matter of these claiming in a continuation application. Claims 113-139 are added. Claims 11, 14, 27-29, 32, 36-38, 45, 46, 48, 49, 57-68, 74, 82-84, 86, 91, and 93-139 are currently pending.

### **B. Support for Amended and Added Claim Language**

Support for amended and added claim language is found throughout the specification and claims as originally filed. Non-limiting support is as follows: support for the language of independent Claim 11 is found in originally filed Claim 11 and in now cancelled Claims 1, 31 and 35; support for language of independent Claim 14 is found in originally filed Claim 14 and in now cancelled Claims 1 and 31; support for language of independent Claims 27, 28, and 29 is found in said claims as originally filed and in now cancelled Claims 1, 31 and 35; support for language of independent Claim 45 is found in Claim 45 as originally filed and in now cancelled Claims 1, 35, 47 and in the specification at lines 22-23 of page 18; support for language of independent Claim 74 is found in said claim as originally filed and in now cancelled Claims 1; support for language of independent Claim 86 is found in originally filed Claim 86 and in now cancelled Claims 1 and 35; support for language of independent Claim 91 is found in originally filed Claim 91 and in now cancelled Claims 1, 31 and 35; and support for language of independent Claim 93 is found in originally filed Claim 93 and in now cancelled Claim 1. Support for dependent claims 113-139 is found in Claim 82, 83, and 84 as originally filed in combination with claims from which they depend.

Therefore, no new matter has been added to the claims by the amendments made in this document.

**C. Supplemental Information Disclosure Statement**

Applicant submits concurrently with this document a Supplemental Information Disclosure Statement. Applicant respectfully requests that the Examiner review the listed documents, make them of record, and return a marked-up copy of the PTO-1449 form to Applicant.

**D. The Rejection Under 35 U.S.C. § 112 Is Overcome**

Claims were rejected under 35 U.S.C. §112 for indefiniteness of the term “small molecule.” See Office Action at pages 2-3.

Applicant disagrees with this rejection. The term “small molecule” would be understood by one of ordinary skill in the art in light of the specification as filed. However, in an effort to further prosecution and secure prompt allowance, claims containing the phrase “small molecule” have either been cancelled or revised to remove the phrase.

Applicant requests that this rejection under 35 U.S.C. §112 be withdrawn.

**E. The Anticipation Rejections Are Overcome**

**1. Davis *et al.* does not anticipate the claimed invention**

Various claims are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Davis *et al.* See Office Action at pages 3-6.

Applicant respectfully disagrees. Claims 1-10, 12-13, 15-26, 30-31, 33-35, 47, 85, 87-90 and 92 are cancelled , and claims 11, 14, 27, 32, 45, 83, 86, 91, and 110 are amended. To anticipate a claim, each and every element of the claim must be found in a single prior art reference. MPEP § 2131. Therefore, to anticipate revised claims 11, 14, 27, 32, 45, 83, 86, 91

and 110, Davis *et al.* must teach, among other things, a method of using a combination of a first nuclease inhibitor and a second nuclease inhibitor as recited by the claims. Applicant asserts that Davis *et al.* do not teach the claimed methods comprising use of a first nuclease inhibitor and a second nuclease inhibitor.

Applicant requests that the rejections under 35 U.S.C. §102(b) over Davis *et al.* be reconsidered and withdrawn.

**2. Kondo *et al.* does not anticipate the claimed invention**

Claims 1, 3-12, 15-18, 21-25, 82-83, and 87-91 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Kondo *et al.* (US 5,470,971). See Office Action at pages 6-7.

Applicant respectfully disagrees. Claims 1, 3-10, 12, 15-18, 21-25, and 87-90 are cancelled, and claims 11, 82, 83 and 91 are amended. To anticipate amended Claims 11, 82, 83, and 91, Kondo *et al.* a reference must teach, among other things, a method using a combination of a first nuclease inhibitor and a second nuclease inhibitor as recited by the claims. Applicant asserts that Kondo *et al.* does not teach the claimed methods comprising use of a first nuclease inhibitor and a second nuclease inhibitor as recited in Claims 11, 82, 83, and 91.

Applicant requests that the rejection under 35 U.S.C. §102(b) over Kondo *et al.* be reconsidered and withdrawn.

**3. Robbi *et al.* does not anticipate the claimed invention**

Claims 1-10, 12, 15-18, 82-83 and 92 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Robbi *et al.*. See Office Action at page 7.

Applicant respectfully disagrees. Claims 1-10, 12, 15-18, and 92 are cancelled, and claims 82 and 83 are amended. To anticipate claims 82 or 83, Robbi *et al.* must teach, among other things, use of a first nuclease inhibitor (a non-proteinaceous polycyclic aromatic structure)

and a second nuclease inhibitor (RNase inhibitor protein) in a method recited by claim 82 or in a solution recited by claim 83. Applicant asserts that Robbi *et al.* fails to teach a first nuclease inhibitor (a non-proteinaceous polycyclic aromatic structure) and a second nuclease inhibitor (RNase inhibitor protein) in a method recited by claim 82 or in a solution recited by claim 83.

Applicant requests that the rejection under 35 U.S.C. §102 over Robbi *et al.* be reconsidered and withdrawn.

**F. The Obviousness Rejection Is Overcome**

Claim 84 is rejected as being unpatentable over Davis *et al.* or Kondo *et al.* or Robbi *et al.* or as applied against claim 1 above and further in view of The Stratagene Catalog p. 39. See Office Action at page 8.

Applicant respectfully disagrees. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *see also* MPEP § 2142.

Claim 84 is amended to incorporate the subject matter of claim 93. Davis *et al.*, or Kondo *et al.*, or Robbie *et al.* fail to teach or suggest use of a first nuclease inhibitor and a second nuclease inhibitor as set forth by Claim 93. The Stratagene catalog at p 39 does not remedy the deficiency of Davis *et al.*, or Kondo *et al.*, or Robbie *et al.* as to a kit comprising a

first nuclease inhibitor and a second nuclease inhibitor of Claim 93 together with components as set forth by Claim 84.

Further, page 39 of the Stratagene catalog provides no motivation to modify Davis *et al.*, or Kondo *et al.*, or Robbie *et al.* to obtain the invention as claimed. For at least these reasons, Applicants respectfully assert that the Examiner has not established a *prima facie* case of obviousness with respect to Claim 84. Because these elements of the *prima facie* case of obviousness have not been met, Applicants need not address the remaining element. Applicants submit that Claim 84 is allowable under 35 U.S.C. §103(a) and, therefore, respectfully request that the rejection under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

**G. Allowability of Claims 109 and 111-112**

Applicant appreciates the Office Action statement regarding the allowability of Claims 109 and 111-112.

**H. Objections to Claims 28-29, 34-38, 46-49, 57-68, 74 and 93-108**

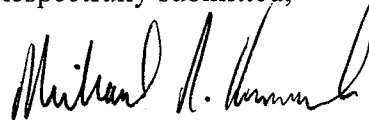
Claims 28-29, 34-38, 46-49, 57-68, 74 and 93-108 were objected to as dependent upon a rejected base claim.

Claims 34, 35, and 47 are cancelled. Claims 28, 29, 36, 37, 48, 49, 57-59, 64, 65, 74, 93, and 97 are revised to incorporate language of base claims, to address antecedent basis or to address informalities.

**I. Conclusion**

The present document is a full and complete response to the July 28, 2006 Office Action. This case is in a condition for allowance, and such favorable action is requested. The Examiner is invited to contact the undersigned Attorney at (512) 536-3020 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael R. Krawzsenek". The signature is fluid and cursive, with a large initial 'M' and a long, sweeping underline.

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